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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,255	03/09/2004	William A. Landi	2003P03684US01	2389

7590 03/27/2007  
Siemens Corporation  
Intellectual Property Department  
170 Wood Avenue South  
Iselin, NJ 08830

EXAMINER
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KINDRED, ALFORD W

ART UNIT	PAPER NUMBER
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2163

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/796,255

Applicant(s)

LANDI ET AL.

Examiner

Alford W. Kindred

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. This action is responsive to communication: Reconsideration filed on 1/12/07.

This action is made final.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Merchen, US# 2003/008877.

As per claim 1, Merchen teaches “obtaining a patient data record of a patient which includes patient identifying information; removing the patient identifying information in the patient data record to generate a de-identified data record” (see paragraph [0089]) “generating an encrypted ID for the patient, wherein the encrypted ID comprises an encrypted representation of one or more items of patient identifying information; and storing the encrypted ID with or in the de-identified data record” (see paragraph [0081] and [0098]).

As per claims 2 and 4, Merchen teaches “encrypting the one or more items of patient identifying information using a public key” (see paragraph [0015] and [0089]).

As per claims 3 and 5, Merchen teaches “securely maintaining a decryption key, which can be accessed by an authorized entity to decrypt the encrypted ID in the de-identified data record to re-identify the patient” (see paragraph [0015], [0024], [0041] and [0089]).

As per claims 6-7, Merchen teaches “wherein the step of removing the patient identifying information in the patient data record to generate a de-identified data record is performed in compliance with a Safe Harbor rule or Limited Data set Rule of HIPAA” (see paragraph [0027], and [0066]-[0067]).

As per claim 8, Merchen teaches “removing database elements that contain patient identifying information” (see paragraph [0088]-[0089]).

As per claim 9-10, Merchen teaches “automatically removing patient identifying information from an unstructured data record” (see paragraph [0089] and [0094]).

As per claims 11-13, Merchen teaches “wherein the text string to be removed from the unstructured data record is determined based on a matching text string that is included in a database element of a structured data record associated with the unstructured data record” (see paragraph [0070], [0089] and [0094]).

As per claim 14, Merchen teaches “manually identifying burned-in patient identifying information within an image and automatically blanking the identified patient identifying information” (see paragraph [[0089] and [0120]).

As per claims 15-18, Merchen teaches “mapping the encrypted ID to a Study ID that comprises an arbitrary human readable ID which contains no patient identifying information; and generating a data structure that includes the mapping” (see paragraph

[0087] and [0094] wherein Merchen's digital certification combined the secrecy of transmission of patient information reads on applicant's claim language).

As per claims 17, Merchen teaches "making the data structure publicly accessible" (see paragraph [0024] and [0069]).

As per claim 19, Merchen teaches "wherein the method is implemented for sharing patient data for purposes of research" (see paragraph [0089] and [0099]).

As per claim 20, Merchen teaches "wherein the method is implemented for sharing patient data for purposes of central monitoring for natural or human induced disease outbreaks" (see paragraph [0120] and [0122]).

As per claims 21-35, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 1-18 and are similarly rejected.

As per claim 36,-39, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 1-5 and are similarly rejected including the following:

--Merchen teaches medical information and financial information (see paragraph [0094] and [0105]).

As per claim 40, this claim is rejected on grounds corresponding to the arguments given above for rejected claims 1-5 and is similarly rejected.

***Response to Arguments***

4. As per applicant's arguments regarding "Merchen does not disclose . . . claimed feature of removing patient identifying information in the patient data record to generate a de-identified data record . . .", examiner disagrees and maintains that Merchen's teachings of the secrecy of patient information via the incorporating encrypting and hashing techniques, reads on applicant's claim language above. Further Merchen's privacy and secrecy elements, clearly removes the ability for unauthorized users to assess a particular patient information, thereby removing patient identification information as implied in applicant's claim language.

As per applicant's claim language regarding "Merchen does not disclose or suggest generating an encrypted ID for the patient, wherein the encrypted ID comprises an encrypted representation of one or more items of patient identifying information . . .", examiner disagrees and maintains that Merchen's teachings involving encrypting and hashing techniques combined with the secrecy elements, reads on applicant's claim language regarding encrypting IDs.

***Conclusion***

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alford W. Kindred whose telephone number is 571-272-4037. The examiner can normally be reached on Mon-Fri 9:00 am- 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2163

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Alford W. Kindred', is positioned above the printed name.

Alford W. Kindred  
Patent Examiner  
Tech Ctr. 2100